

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of  
Ilana (Helena) Nathan

Confirmation No.: 5690  
Date: December 29, 2008  
Group Art Unit: 1654  
Examiner: Ronald T. Niebauer

Serial No.: 10/509,405

Filed: September 24, 2004

For: COMPOSITIONS AND METHODS FOR TREATING AND PREVENTING  
NECROSIS

---

**VIA EFS - WEB**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO SPECIES ELECTION REQUIREMENT**

Sir:

In the Office Action mailed in this case on June 25, 2008, claims 1, 3-4 and 15-17 are subject to a species election requirement.

The Examiner is requiring the applicant to elect a specific species of an “anti-apoptotic agent” as that term is used in certain of the claims.

Applicant, therefore, elects without traverse the species of anti-apoptotic agent known as z-VAD-fluoromethylketone (“fmk”). Claims 1, 3-4 and 15-17 are all believed to be generic and Applicants believe that claims 1, 3-4 and 15-17 all encompass the herewith elected species, fmk.

The elected agent is a species of the genus caspase inhibitors, which genus is specifically taught in applicant’s specification as being useful as an anti-apoptotic agent in the practice of the claimed invention (see the paragraph bridging pp. 10-11 of International Publication No. WO 03/079969). While the elected species is not specifically recited in the specification, applicant respectfully submits that one having an ordinary level of skill in this art at the time the invention was made would readily recognize z-VAD-fmk to be a member of the class of caspase inhibitors. Submitted herewith in support is a declaration of co-inventor, Professor Ilana Nathan, which discusses certain experiments carried out by Prof. Nathan (or performed under her supervision) which support the following conclusions: (1) z-VAD-fluoromethylketone (z-VAD-fmk), in

combination with elastase inhibitors such as elastase inhibitor III, effectively serve to reduce KCN-induced cell necrosis; and (2) that one of ordinary skill at the time of the filing of the present application in 2004 would recognize and understand that z-VAD-fluoromethylketone is a typical member species among the class of effective anti-apoptotic agents known as caspase inhibitors.

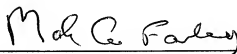
Entry of this response into the file of the present application is, therefore respectfully requested.

#### **CONTINGENT EXTENSION REQUEST**

If this communication is filed after the shortened statutory time period had elapsed and no separate Petition is enclosed, the Commissioner for Patents is petitioned, under 37 C.F.R. § 1.136(a), to extend the time for filing a response to the outstanding Office Action by the number of months which will avoid abandonment under 37 C.F.R. § 1.135. The fee under 37 C.F.R. § 1.17 should be charged to our Deposit Account No. 15-0700.

THIS CORRESPONDENCE IS BEING  
SUBMITTED ELECTRONICALLY  
THROUGH THE PATENT AND  
TRADEMARK OFFICE EFS FILING  
SYSTEM ON December 29, 2008.

Respectfully submitted,



---

Mark A. Farley  
Registration No.: 33,170  
OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
Telephone: (212) 382-0700

MAF:stb